

REMARKS

Introductory Comments:

Claims 11, 12, and 14-20 were examined in the Office Action dated October 02, 2007.

Claims 11, 12, and 14-20 were rejected on the grounds of non-statutory obviousness-type double patenting over U.S. Patent No. 6,686,152.

Claims 11, 12, and 14-20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,470,705 to Grossman et al. (Grossman) in view of U.S. Patent No. 5,994,049 to Hall et al. (Hall).

The applicants thank the Examiner for withdrawing the previous rejection of the claims as being unpatentable over Grossman in view of Babon.

SUPPORT FOR THE AMENDMENTS

Claims 14 and 19 have been amended to depend from claim 12 instead of the cancelled claim 13. The amendment thus corrects for antecedent basis.

Claims 17 and 18 have been amended to delete the dependence from the cancelled claim 13. The amendment thus corrects for antecedent basis.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

Addressing the Examiner's Rejections

Rejections of the Claims Under 35 U.S.C. §103(a)

The Examiner rejected claims 11, 12, and 14-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Grossman in view of Hall.

The applicants traverse the rejection. In order for the Office to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The combination of the cited references do not disclose all the elements of the applicants' claims, therefore, a *prima facie* case of obviousness has not been made.

The Examiner acknowledges that Grossman does not explicitly disclose the capture agent which confers on the undigested electrophoretic probes a charge that causes the undigested electrophoretic to migrate upon electrophoretic separation in a direction opposite of that of the e-tag reporters, thereby excluding said undigested electrophoretic probes from the electrophoretic separation of the released e-tag as recited in claim 11. However, the Examiner states that Hall discloses a capture ligand at column 9, lines 3-6 and column 68, lines 23-28. The applicants disagree and draw the Examiners attention to column 9, lines 1-3 where Hall states: "It is also contemplated that labelled oligonucleotides (cleaved or uncleaved) may be separated by means other than electrophoresis." At column 68, lines 23-28, Hall again states that the "labeled RNA may also be captured onto a solid support, such as a microtitre plate, a bead or a dipstick..."

The use of biotin and antibody highlighted by the Examiner is for the separation other than electrophoresis. This teaches away from the Applicants' claims that recite electrophoretic separation of the probes.

The applicants previously had amended the independent claim 11 to recite that eTag reporter of each electrophoretic probe has a negative charge upon release and the capture agent confers on the undigested electrophoretic probes a positive charge. Neither Grossman nor Hal, either alone or in combination, disclose this element of claim 11. Hall teaches that a positively charged group can be attached to the oligonucleotides to reduce the negative charge on the oligonucleotides (column 124, line 64 to column 125, line 21). Then, the oligonucleotide can be shortened through the action of a Cleavase® enzyme thereby "flipping" the net charge of the labeled entity. Thus, the labeled oligonucleotide has a net negative charge, and after cleaving, has a positive charge due to "flipping." This is opposite to what is claimed by the Applicants. As stated above, the independent claim 11 recites that eTag reporter of each electrophoretic probe has a negative charge upon release and the capture agent confers on the undigested electrophoretic probes a positive charge.

The combination of Grossman and Hall does not disclose all the elements of the claims, and therefore, a *prima facie* case of obviousness has not been presented by the Office. Therefore, the Examiner is respectfully requested to withdraw the rejection.

Provisional Rejections of the Claims Under Double Patenting

Claims 11, 12, and 14-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,686,152. The applicants will consider filing a terminal disclaimer upon indication of allowable subject matter.

CONCLUSION

Applicants respectfully submit that the claims define an invention that is patentable over the art, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (650) 335-7818.

Respectfully submitted,
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